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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/559,881	04/26/2000	Michael R. Schrimpf	6494.US.O2	1781

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[REDACTED] EXAMINER

COLEMAN, BRENDA LIBBY

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1624

DATE MAILED: 02/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. <b>09/599,881</b>	Applicant(s) <b>SCHRIMPFF et al.</b>
	Examiner <b>Brenda Coleman</b>	Art Unit <b>1624</b>



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 30 days ~~MONTHS~~ FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1)  Responsive to communication(s) filed on \_\_\_\_\_.
- 2a)  This action is FINAL.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

#### Disposition of Claims

- 4)  Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) \_\_\_\_\_ is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claims 1-38 are subject to restriction and/or election requirement.

#### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

- 15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 5)  Notice of Informal Patent Application (PTO-152)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 6)  Other: \_\_\_\_\_

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## **DETAILED ACTION**

Claims 1-38 are pending in the application.

### ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 2 and 15-28, drawn to compounds, compositions and method of use of the compounds of formula I where Z is an azepine ring, classified in class 540, subclasses 597, 598, 601 and 603 and class 514, subclasses 217.04, 217.05, 217.06, 217.07 and 217.10.
- II. Claims 1, 2, 9-14 and 19-28, drawn to compounds, compositions and method of use of the compounds of formula I where Z is a piperidine ring, classified in class 546, subclasses 193 and 209 and class 514, subclasses 318 and 326.
- III. Claims 1, 2, 6-8 and 19-28, drawn to compounds, compositions and method of use of the compounds of formula I where Z is an pyrrolidine ring, classified in class 548, subclasses 213, 214, 244, 245 and 246 and class 514, subclasses 343, 372 and 380.
- IV. Claims 1-5 and 20-28, drawn to compounds, compositions and method of use of the compounds of formula I where Z is an azetidine ring, classified in class 548, subclass 953 and class 514, subclasses 210.18, 210.20 and 210.21.

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V. Claims 29-38, drawn to compounds, compositions and method of use of the compounds of formula VIII where R<sub>3</sub> is an azepine ring, classified in class 540, subclass 598 and class 514, subclass 217.05.

VI. Claims 29-38, drawn to compounds, compositions and method of use of the compounds of formula VIII where R<sub>3</sub> is a piperidine ring, classified in class 544, subclass 238 and class 514, subclass 252.03.

VII. Claims 29-38, drawn to compounds, compositions and method of use of the compounds of formula VIII where R<sub>3</sub> is a pyrrolidine ring, classified in class 544, subclass 238 and class 514, subclass 252.05.

VIII. Claims 29-38, drawn to compounds, compositions and method of use of the compounds of formula VIII where R<sub>3</sub> is an azetidine ring, classified in class 544, subclass 238 and class 514, subclass 210.18 and 210.20.

The inventions are distinct, each from the other because of the following reasons:

Groups I-VIII are directed to structurally dissimilar compounds such that the variable core created by the varying definitions of Z in formula I and R<sub>3</sub> in formula VIII do not belong to a recognized class of chemical compounds in the art, and references anticipating one invention, would not render obvious the others, for example azepine is different from piperidine, pyrrolidine, etc. Thus, separate searches in the literature as well as in the U.S. Patent Classification System would be required. Each group's compounds are made and used independently of each other and could support separate patents. The compounds differ significantly in chemical structures. One

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skilled in the art would not consider such diverse structures as functional equivalents of each other. The mere fact that there is a single similarity is not in itself a significant reason to render the whole embodiment obvious.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

**Tentative election of a single species within the elected group is further required.**

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Mondays from 8:30 AM to 5:00 PM, on Tuesdays from 8:00 AM to 4:30 PM, on Wednesday thru Friday from 9:00 AM to 5:30 PM.

The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

*Brenda Coleman*  
Brenda Coleman  
Primary Examiner AU 1624  
February 12, 2003